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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,347	03/27/2001	Bruce H. Prince	52372-00002	1204

30223 7590 10/28/2003  
JENKENS & GILCHRIST, P.C.  
225 WEST WASHINGTON  
SUITE 2600  
CHICAGO, IL 60606

EXAMINER

ALIMENTI, SUSAN C

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/818,347

Applicant(s)

PRINCE, BRUCE H.

Examiner

Susan C. Alimenti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-14 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 2,9 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. In response to Applicant's Appeal Brief filed on 19 August 2003, arguments presented by the Applicant are considered persuasive and the finality of the Office Action of Paper No. 8 is withdrawn. Action on the merits is as stated below.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-8, 11-14, 17-19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rimback (US 5,685,109), and further in view of Clemmons (US 4,858,374).

4. Regarding claims 1, 4-6, 8, 11 and 12, Rimback discloses the claimed invention except the housing contains bait. In Figure 1 it can be seen that the trap comprises two side panels (12,14), each including a hole (40,42) therein for the entrance of an insect, and an integral latching means (56) latching the two sidewalls together. Rimback's trap is made of plastic, which has a smooth surface and further comprises hinges (18,20) that allow for the device to be opened and closed to repeatedly remove the contents therein. Furthermore, while Rimback mentions that the trap may be used in conjunction with some type of bait, it is merely stated that the trap is "more attractive to the insects" with the bait, and it is therefore inferred that said trap is functional without bait (Rimback, col.3, lns.36-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the bait from Rimback's

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trap, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

5. Regarding claims 14 and 17-19, Rimback discloses the claimed method of providing a housing having a hollow interior, and periodically removing the trapped bees from said hollow interior except Rimback uses bait. It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the bait from Rimback's trap, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

6. Regarding claims 7, 13 and 20, Rimback as modified above, discloses the claimed invention except the exact size of the hole is not disclosed, however it is inherent that the size of the hole be appropriate for flying insects such as bees or wasps, since the trap is meant for such insects. Clemmons discloses a device in the same field of endeavor, i.e. traps for flying insects such as bees or the like. Clemmons determined that the proper hole dimension should be between 6-13 millimeters (0.24-0.51 in.) in order to allow enough room for a bee to crawl through but prevent it from flying through, which is exactly what the present invention seeks to accomplish when dealing with carpenter bees (Clemmons, col.2, lns.54-56). A hole large enough to allow a carpenter bee to fly through would not be as attractive to said bee since it would not recognize this as one that a carpenter bee would create which is well-known to be a safe-zone for the insect. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Rimback's insect entry hole between 5/16-1/2 in. (0.31-0.5

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in.) in order to make a hole large enough for a bee to fit through but one that would prevent the insect from flying therethrough.

7. Claims 3, 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable by Rimback, in view of Clemmons and further in view of Schneidmiller (US 4,551,941).

Regarding claims 3, 10 and 16 Rimback as modified, discloses the claimed invention except the color of the exterior surface around the hole is not specified. Schneidmiller discloses an insect trap, in the same filed of endeavor, i.e. traps for flying insects, and he teaches the use of a bright yellow color to attract wasps or the like (Schneidmiller, col. 4, lns.51-54). The insects enter into the trap through a bottom element (45) that is colored yellow and Schneidmiller explains that said bottom element is made of an opaque material that prevents the passage of light (Schneidmiller, col.6, lns.16-19). He further states how the entrance appears darker to the insect upon entry into the trap (Schneidmiller, col.7, lns.9-13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rimback's device by manufacturing it from a bright colored plastic that would be more attractive to the insects and furthermore provide a more drastic contrast making the entrance appear darker and striking to the insect.

***Allowable Subject Matter***

8. Claims 2, 9 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 703-306-0360.

The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles T. Jordan can be reached on 703-306-4159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

SCA

*Charles T. Jordan*  
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